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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,194	11/29/2001	Steven Michael Grimm	1719.0030004	4005

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EXAMINER

DINH, DUNG C

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/997,194

Applicant(s)

GRIMM ET AL.

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/7/02</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

Claims 1-20 are present for examination.

***Priority dates***

The present invention is filed 11/29/2001. The present application claims priority to:

09/578,683 filed 5/26/2000;

08/821,279 filed 3/20/1997; and

60/013,812 filed 3/21/1996.

Current claims 11-15 recited establishing a match for voice and data, and application supporting voice and data. This feature is not disclosed in the specification of any of the prior parent applications. Therefore, the limitation of data and voice application in claims 11-15 only entitles to the filing date of the present application - 11/29/2001.

***Objection to the Specification***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The specification is objected to because the detail disclosure does not have a written description for the limitation of application supporting voice and data as claimed in claims 11-15. Correction is required.

### ***Claim Rejections - Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,894,556. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite essentially equivalent limitations.**

Current Application Claim 1	Patent 5,894,556 Claim 1
method for establishing peer-to-peer match of clients ...	method for a match maker to match an additional computer ... with a first existing computer
receiving at least one offer ... from an offering peer client, and	<i>(first existing computer)</i> having previously communicated to the match maker a desire to match ...
recording at least one attribute associated with said offer using at least one offer record;	<i>(inherent in order for the match maker to remember that the first existing computer has a previously communicated an offer)</i>
receiving a measurement of at least one communication link property between the offering client and an inquiring client;	(c) measuring, ...prior to matching ... at least one communication attribute between said additional computer and said first existing computer; <i>(The match maker inherently would have received the measurement in order to perform</i>

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	<i>the match decision.)</i>
comparing said offer record with said measured at least one link property to determine if a peer to peer match between said offering and said inquiring clients is to be permitted.	(d) selecting said first existing computer as a match to said additional computer based on a comparison of said at least one communication attribute measured ...

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearlman US patent 5,586,257 and further in view of Scott Coleman "Re: ifrag server", Usenet posting to rec.games.computer.doom.misc 04/23/1995 and Alec Habig "Re: 'Normal' lag?!?", Usenet posting to rec.games.netrek 6/22/1995.

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As per claim 1, Perlman teaches method for establishing peer-to-peer match of clients, comprising:

receiving at least one offer from an offering peer client (col.10 lines 64-68), and recording at least one attribute associated with the offer in an offer record (e.g. a particular game and address of the offering computer and other attributes, see col.11 lines 7-24);

comparing said offer record to determine if a peer to peer match between an offering and an inquiring clients is to be permitted. (col.11 lines 7-24).

Pearlman does not disclose receiving a measurement of at least one communication link property between the offering client and an inquiring client and matching based on comparison of the measured link property. Pearlman matches based on area code and makes direct modems connection between the clients. (Col.11 lines 35-32). Direct modem connection permits connection of only two machines to play. However, the trend at the time of the invention was to play with multiple players over the Internet. It is known at the time of the invention that communication link properties such as latency, packet loss, etc. between the players effect playablity of the game over the Internet (see A3 on page 2 of Scott Coleman "Re: ifrag server" and Alec Habig's posting). Coleman discloses a Frag Tracker

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server that maintains a list of players and location and enable players to find each other and to directly connect to each others (peer-to-peer) to play over the Internet. (see page2 A3). It would have been obvious for one of ordinary skill in the art to combine the Frag Tracker with Pearlman teaching because it would have enabled players to find and play with multiple other players over the Internet. It would have been obvious that Pearlman as modified would include the determination of the communication link properties (i.e. ping, packet loss, etc) between the players in order to match players that are near each other.

As per claim 2, Pearlman and Coleman teach launching application to permit peer to peer communication between the clients (Pearlman col.11 line 60 to col.12 line 32 -direct modem connection between the players. Coleman page 2 A3: ... "Once the game actually begins, ... the ONLY traffic generated ... is between the machines involved in the game."

As per claim 3, Pearlman teaches launching application allowing direct peer to peer communication after a predetermined number of inquiring clients are deemed allowable matches (two - A and B, col.11 lines 7-24).

As per claim 4, Pearlman teaches comparing offering record with link property (col.11 lines 7-24: area code and telephone



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number and other information). It would have been obvious in Pearlman as modified to include communication link property in the offering record to determine peer match because it would have enabled an offering player to specify link property such as how much latency he is willing to tolerate.

As per claim 5, it is well known in the art that link properties relevant for playing game include bandwidth, latency, and packet loss (see Alec Habig's posting).

As per claim 6, it is rejected under similar rationale as for claim 1 above. It would have been obvious in Pearlman as modified to include communication link property in the offering record to determine peer match because it would have enabled an offering player to specify link property such as how much latency he is willing to tolerate.

As per claim 7, Pearlman does not disclose measuring link properties between the clients before initiate the peer to peer match. However, it would have been obvious in Pearlman as modified to measure the link properties between the clients before initiating the peer to peer match in order to ensure that the links between clients are within desired parameters.

As per claim 8, Pearlman does not disclose attribute include instance and class attribute. Official notice is taken that it is well known in the art at the time of the invention to use object

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oriented programming. The advantages of object oriented programming are well known in the art. Instance and class attribute are known properties of object oriented programming. Hence, it would have been obvious for one of ordinary skill in the art to implement Pearlman as modified using objected oriented programming because it provided better management of the software lifecycle for example.

As per claim 9, it is inherent that Pearlman as modified would have included code in the client for measuring link properties (a ping program for example).

As per claim 10, It is apparent from Pearlman teaching that the code for recording offer, code for recording link performance and code for comparing are part of an application (col.11 lines 7-24, the software on the server for performing the matching of the players).

As per claims 11-15, they are rejected under similar rationale as for claims 1-5 above. Pearlman does not disclose the application supporting voice and data. Games supporting both voice and data are well known at the time of the filing of the current application. The matching function of Pearlman as modified is independent of the type of application. Hence, the type of application used clearly would have been a matter of choice of the players. It would have been obvious for the players

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to use an application (game) supporting voice and data communication because it would have enable the players to verbally communicate while playing the game with each others.

As per claim 16, it is rejected under similar rationale a for claim 1 above. Pearlman and Coleman does not specifically disclose matching offering client to game server. Official notice is taken that it is known at the time of the invention to have multiplayer games that permit a player machine to act as a server to host a game for others to join in (e.g. DOOM, Descent, etc.). Hence, it would have been obvious for one of ordinary skill in the art to match offering clients to game servers (e.g. players who are hosting games) so as to enable the system to match clients who want to join a game with players who are hosting a game.

As per claim 17, Pearlman and Coleman teach instantiating the application to permit communication between the players (Pearlman col.11 line 60 to col.12 line 32 -direct modem connection between the players. Coleman page 2 A3: ... "Once the game actually begins, ... the ONLY traffic generated ... is between the machines involved in the game."

As per claim 18, It would have been obvious in Pearlman as modified to select a plurality of servers to compare to the request from the offering client because it would have enable the

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system find a best possible matching server for the offering client.

As per claim 19, Pearlman does not teach matching based on a second measured link property. However, it is well known in the art that link properties relevant for playing game include bandwidth, latency, and packet loss (see Alec Habig's posting). Hence, it would have been obvious for one of ordinary skill in the art to match the players based on two or more links properties to ensure a good link between the players.

As per claim 20, Pearlman does not teach deselecting one of the server. This step is apparent in the matching process. It would have been obvious to one of ordinary skill in the art to deselect a server that does not meet the matching criteria in order to reduce the number of candidate servers to a few or one best server.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Dung Dinh', with a stylized, looping flourish extending from the end.

Dung Dinh  
Primary Examiner  
March 22, 2006